

- III. Claims parts of 1-8, 11-23, and 25, drawn to compounds where ring A formula (I) is homopiperidine, classified in class 540, subclass 610, among others.
- IV. Claims parts of 1-9, 11-23, and 25, drawn to compounds where ring A of Formula (I) is imidazoline, classified in class 548, subclass 334.1, among others.
- V. Claims parts of 1-9, 11-23, and 25, drawn to compounds where ring A of Formula (I) is pyrazoline, classified in class 548, subclass 379.4, among others.
- VI. Claims parts of 1-23 and 25-29, drawn to compounds where ring A formula (I) is all other azaheterocyclyl rings, classified in class 540, subclass 544, among others.
- VII. Claim 26, drawn to treating Factor Xa patients, classified in class 514, subclass 423.
- VIII. Claim 27, drawn to treating thrombin patients, classified in class 514, subclass 423.
- IX. Claim 28, drawn to inhibiting Factor Xa, classified in class 514, subclass 423.
- X. Claim 29, drawn to inhibiting thrombin, classified in class 514, subclass 423.

Applicants are also required to elect a species if Group VI is selected for prosecution.

In response, solely to be responsive to the requirement for restriction, Applicants provisionally elect, **WITH TRAVERSAL**, to prosecute the claims of **Group I**, *i.e.*, claims 10, 24, and parts of 1 to 9, drawn to compounds where ring A of Formula (I) is pyrrolidine. Furthermore, although the Action did not request a species election in the event that Group I was chosen, Applicants wish to offer the compound 3-(R)-(3-Carbamimidoylphenyl)-2-(R)-{1-[4-(6-oxo-1,6-dihydropyrid-3-yl)-benzoyl]-pyrrolidin-2-yl}-propionic acid methyl ester trifluoroacetate, which is the subject of Example 12, at pages 54 to 57 of the present patent application. Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Requirement for Restriction to allow prosecution of more than one group of claims designated by the Examiner for reasons herein provided.

Whether restriction is proper depends upon whether a serious burden exists:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (8th ed., August 2001). Significantly, the Action failed to make such showing. In this regard, Applicants submit respectfully that the Action has provided *no* evidence or reasoning to support the election/restriction requirement or to show that the requisite serious burden exists. Indeed, the Action is *completely silent* with respect to any allegation of a serious burden. Applicants respectfully submit that the examination of Groups I, II, and III, for example, would *not* present an undue burden on the Examiner because pyrrolidines, piperidines and homopiperidines differ only by ring size, and may all be characterized as monoaza saturated heterocyclic ring systems. Thus, searching Groups I, II and III together should not pose an undue burden on the Examiner. Accordingly, reconsideration and withdrawal of the election/restriction requirement or, in the alternative a modification thereof, are respectfully requested.

If the present restriction requirement is maintained, Applicants request respectfully that, upon identification of allowable subject matter of the elected product claims, the non-elected method of treating claims commensurate in scope with the allowed product claims be rejoined in accordance with MPEP § 821.04. If such should occur, Applicants request the opportunity to further amend the rejoined method claims prior to their examination.

Clarification of Inventorship

Applicants stated in their Communication dated January 25, 2005 ("the Communication"), that "a new Declaration & Power of Attorney pursuant to 37 C.F.R. § 1.63(e) is submitted herewith naming (1) Mark Czekaj and (2) Heinz W. Pauls *as the inventors of the subject matter of claims 1 to 29*, the only claims pending in the instant patent application" (emphasis added). Applicants wish to clarify that this statement, however, should have more clearly specified that (1) Mark Czekaj and (2) Heinz W. Pauls were the inventors of the subject matter newly

encompassed within claims 1 to 29, and that Scott Klein remains an inventor by virtue of his contribution to the claimed subject matter prior to his departure from the employ of the present assignee.

As explained in the Communication, the above-identified patent application was filed on October 16, 2003 as a continuation-in-part ("CIP") of patent application Serial No. 10/143,190, filed May 10, 2002 ("the 190 application"). A copy of the Declaration and Power of Attorney from the 190 application was originally submitted with the instant CIP, naming (1) Mark Czekaj, (2) Scott Klein, and (3) Heinz W. Pauls as the inventors; however, because the present CIP, by definition, includes new matter relative to the 190 application, a new oath or declaration is required pursuant to 37 C.F.R. § 1.63(e).

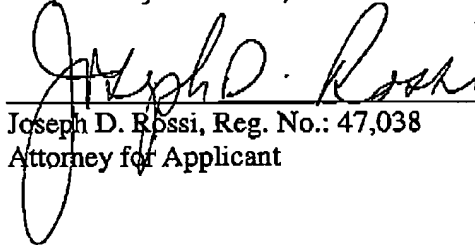
As explained further in the Communication, the new declaration was signed by only two of the three originally named inventors because the "new matter" to which this new declaration attested was invented after one of the originally named inventors, Scott Klein, ended his employ with the present assignee. The inventors of the instant claims, however, remains listed as (1) Mark Czekaj, (2) Scott Klein, and (3) Heinz W. Pauls, *i.e.*, the same three named inventors on the 190 application. Thus, Mr. Klein has executed a declaration stating that he is an inventor of the subject matter of the present claims along with Mr. Czekaj and Dr. Pauls, and Mr. Czekaj and Dr. Pauls. Separately, Mr. Czekaj and Dr. Pauls executed a declaration stating that they are the inventors of the new subject matter included in the claims relative to those filed in the 190 application. Applicants request the Examiner's acknowledgement of this point regarding inventorship in the next Office Action.

Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Action of record. Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,



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